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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,076	04/18/2001	David D. Hadden	1004-001	8830

7590 11/24/2004

Mr. Gene Pease, CEO  
Capital Analytics, Inc.  
1812 Chapel Hill Drive  
Durham, NC 27707

EXAMINER
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COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,076

Applicant(s)

HADDEN ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-9,11,14-19,21 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,11,14-19,21 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on August 24, 2004. Claims 2, 3, 10, 12, 13, 20, 22, 23 and 30 have been cancelled. Claims 1, 4-9, 11, 14-19, 21 and 24-29 have been amended. Claims 1, 4-9, 11, 14-19, 21 and 24-29 are now pending in this application.

### ***Response to Amendment***

2. Applicant's amendments to claims 1, 4-9, 11, 14-19, 21 and 24-29 are acknowledged.

The amendment to claim 1 is insufficient to overcome the 35 U.S.C. 101 technological arts rejection set forth in the previous Office Action since the amendment adding use of technology is a nominal recitation only in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, the use of technology must be recited in the body of the claim to overcome the 35 U.S.C. 101 technological arts rejection.

The amendments to the claims are sufficient to overcome the 35 U.S.C. 112, second paragraph rejections set forth in the previous Office Action; therefore the 35 U.S.C. 112, second paragraph rejections are withdrawn.

***Response to Arguments***

3. Applicant's arguments have been fully considered, but are found unpersuasive.

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In the Remarks, Applicant presents similar arguments as in the previous response: that Nashner does not disclose or teach the steps of claim 1.

In response to argument, Examiner respectfully disagrees and further submits that Nashner does disclose the elements of claim 1, including: quantifying a first actual performance metric (col. 4, lines 52-55; The system records at least one performance metric of an individual prior to the training program (i.e., event occurrence).) for a defined performance (col. 4, lines 55-58; The system defines expected performance in terms of quality and quantity of executed tasks.) before an event occurrence increasing the actual skill level for the possessed skill of the individual (col. 4, lines 58-61; The system monitors progress towards performance goals, meaning that the training (i.e., event occurrence) affects the skill of the individual in such a way as to improve the performance of the individual carrying out the task. Since the system monitors training effectiveness, the training must bear on the actual skill level of an individual.), wherein increasing the actual skill level of the individual may or may not increase the defined performance of the individual (col. 4, lines 58-61; As discussed in the previous limitation, in the case of Nasher, the skill of the individual does increase the defined performance for the individual carrying out the task. Since the limitation, *may or may not increase* the defined performance of the individual, is in the alternative, a prior art reference that does either or is sufficient to anticipate the claim.);

Additionally, Examiner respectfully submits that Nasher teaches quantifying a second actual performance metric after the event occurrence and analyzing a relationship between the first and second actual performance metrics and the actual skill level of the individual before and after the event occurrence (col. 4, lines 24-30; col. 5, lines 51-67; Table 1; The system measures multiple performance metrics of an individual before and after training. The system takes performance metrics prior to and after training in order to determine training effectiveness and to monitor compliance with program goals. Thus, a determination of training effectiveness cannot be made without a comparison between a performance metric of an individual prior to training and a performance metric of an individual after training.); and determining whether the event occurrence increasing the actual skill level of the individual also increases the defined performance of the individual based at least partially on the relationship between the first and second actual performance metrics and the actual skill level of the individual before the event occurrence (col. 4, lines 58-61; col. 5, lines 15-19 and lines 41-44; Figure 1; The system compares first and second performance metrics of an individual to determine a result of the training on the ability of the individual to perform (quantity and quality) certain tasks.).

Thus, Examiner respectfully submits that Nashner does disclose all of the elements of claim 1 except for the limitation regarding a *business* outcome.

With regard to Applicant's arguments that Nashner does not disclose defining a role for fulfilling a desired *business* outcome, the argument is moot as Examiner has provided a new rejection for the newly added limitation.

Accordingly, Applicant's arguments have been fully considered, but found unpersuasive and claims 1, 4-9, 11, 14-19, 21 and 24-29 stand rejected.

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***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 4-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the steps of method claims 1 and 4-9 recite quantifying first and second performance metrics of an individual before and after an event and determining a result of the event on an ability of the individual to carry out a task based on the first and second performance metrics; however, the steps do not apply, involve,

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use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology.

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As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention quantifies first and second performance metrics of an individual before and after an event (i.e., concrete) and determines a result of the event on an ability of the individual to carry out a task based on the first and second performance metrics (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1 and 4-9 are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-9, 11, 14-19, 21 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nashner (U.S. 6,190,287).

As per claim 1, Nashner discloses a method comprising:

a) defining a role associated with a required skill having a required skill level and a defined performance (col. 4, lines 46-63; col. 6, line 63-col. 7, line 1; The system defines a role for an individual that includes expected performance in terms of quality and quantity of executed tasks.); and

b) associating an individual with the role, the individual having a possessed skill correlating with the required skill of the role and an actual skill level quantifying the possessed skill (col. 4, lines 46-63; col. 7, lines 1-11; The invention as disclosed by Nashner compares the individual being evaluated with a "norm." Furthermore, by having a reference population possessing the "norm," the invention is associating individuals with certain skills required for certain roles and is further quantifying such characteristics.).

c) quantifying a first actual performance metric for the defined performance of the individual before an event occurrence increasing the actual skill level for the possessed skill of the individual, wherein increasing the actual skill level of the individual may or may not increase the defined performance of the individual (col. 4, lines 48-55; Figure 1; The system records at least one performance metric of an individual prior to the training program (i.e., event occurrence). The system defines expected performance in terms of quality and quantity of executed tasks. The system monitors progress towards performance goals, meaning that the training (i.e., event occurrence) affects the skill of the individual in such a way as to improve the performance of the individual carrying out the task. Since the system monitors training effectiveness, the training must bear on the actual skill level of an individual.);



d) quantifying a second actual performance metric for the defined performance of the individual after the event occurrence (col. 4, lines 58-61; col. 5, lines 11-15; Figure 1; The system measures multiple performance metrics of an individual before and after training. The system takes performance metrics prior to and after training in order to determine training effectiveness and to monitor compliance with program goals. Thus, a determination of training effectiveness cannot be made without a comparison between a performance metric of an individual prior to training and a performance metric of an individual after training.);

e) analyzing a relationship between the first and second actual performance metrics and the actual skill level of the individual before and after the event occurrence (col. 5, lines 51-67; Table 1; The system takes performance metrics prior to and after training in order to determine training effectiveness and to monitor compliance with program goals. Thus, a determination of training effectiveness cannot be made without a comparison between a performance metric of an individual prior to training and a performance metric of an individual after training.); and

f) determining whether the event occurrence increasing the actual skill level of the individual also increases the defined performance of the individual based at least partially on the relationship between the first and second actual performance metrics and the actual skill level of the individual before the event occurrence (col. 4, lines 58-61; col. 5, lines 15-19 and lines 41-44; Figure 1; The system compares first and second performance metrics of an individual to determine a result of the training on the ability of the individual to perform (quantity and quality) certain tasks.).

Nasher does not expressly disclose defining a role for fulfilling a desired *business* outcome. However, the limitation, *for fulfilling a desired business outcome*, is mere intended field of use. Whether the role is for a *business* outcome as claimed, or for a *physical fitness* outcome as taught by Nashner, is irrelevant since the intended field of use does not change the overall functionality of the claimed system. Since the environment or field of use that is applied to the claimed invention does not change the overall functionality of the invention, the intended field of use does not hold any patentable weight. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Accordingly, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the general idea of the training system of Nashner, which compares a user's skill and performance before training with the user's skill and performance after training to determining the effect of the training on the user's skill and performance, to a business environment because it is old and well known for businesses to determine the effectiveness of their training programs on their employees. By monitoring training program effectiveness on their employees, businesses can determine what actions to take to ensure that training programs are successful, thus also ensuring employees are provided the tools to work effectively and efficiently.

As per claim 4, Nashner discloses the method of claim 1 further comprising:

a) analyzing a difference between the required skill level for the role and the actual skill level of the individual (col. 7, lines 2-6; The system performs an initial evaluation of the individual's deficit from the "norm," or required skill level.);

b) determining if training is necessary to raise the actual skill level to the required skill level (col. 7, lines 6-8).

As per claim 5, Nashner discloses the method of claim 1 wherein the defining step further comprises associating a desired performance metric for the defined performance associated with the role and further comprising associating the individual having an actual performance metric correlating with the desired performance metric of the role to the role (col. 7, lines 2-6; Nashner discloses evaluating the individual's performance capabilities relative to the performance goals based on the "norm.").

As per claim 6, Nashner discloses the method of claim 1 further comprising: comparing the actual skill level of the individual before and after the event occurrence (col. 4, lines 46-63; col. 7, lines 9-10; The system measures current skill levels and then monitors performance to determine a change in the skill levels.); and

correlating any difference between the actual skill level of the individual before and after the event occurrence with the ability of the individual to carry out the defined performance (col. 7, lines 11-12; Table 2).

As per claim 7, Nashner discloses the method of claim 1 further comprising: comparing the actual skill level of the individual before and after the event occurrence with the first and second actual performance metrics (col. 7, lines 2-11); and

determining a result of changes in the actual skill level of the individual before and after the event occurrence on the ability of the individual to carry out the defined performance (col. 7, line 27-col. 8, line 11).

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As per claim 8, Nashner discloses the method of claim 1 wherein the event occurrence is a training event bearing on the actual skill level of the individual and further comprising:

quantifying a first actual performance metric for the defined performance of a second individual associated with the role before the training event (col. 6, line 63-col. 7, line 1; col. 8, lines 62-67; The invention as disclosed by Nashner compares the individual being evaluated with a reference population "norm." In doing so, the invention is associating a group of individuals with certain skills required for certain roles and is further quantifying such characteristics.);

quantifying a second actual performance metric for the defined performance of the second individual after the training event, wherein the second individual is not subjected to the training event (col. 6, line 63-col. 7, line 1; col. 8, lines 62-67; The invention as disclosed by Nashner compares the individual being evaluated with a reference population "norm." In doing so, the invention is associating a group of individuals with certain skills required for certain roles and is further quantifying such characteristics. Furthermore, the group of individuals are not subjected to the training.); and

comparing the first and second actual performance metrics of the second individual with the first and second actual performance metrics of the individual to

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determine effectiveness of the training event on the actual skill level (col. 4, lines 21-30 and 46-63; col. 7, lines 2-11; The system uses comparisons between first and second performance metrics to monitor training effectiveness.).

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As per claim 9, Nashner discloses the method of claim 8 further comprising:

identifying an increase between the first and second actual performance metrics of the individual and the second individual (col. 7, lines 37-41; Table 2; The system measures training effectiveness, where training is considered effective if there is an increase/improvement between the first and second performance metrics and training is considered ineffective if there is either no increase/improvement or even a decrease between the first and second performance metrics.); and

indicating an influence other than the training event causing the increase between the first and second actual performance metrics of the individual and the second individual (col. 6, lines 63-67; col. 7, line 10-col. 8, line 5; Tables 1 and 2; The system also evaluates an individuals' motivation in determining a difference between first and second performance metrics.).

Claims 11, 14-19, 21 and 24-29 recite substantially similar limitations as claims 1 and 4-9 above. Therefore, claims 11, 14-19, 21 and 24-29 are rejected on the same basis as claims 1 and 4-9 above.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Collins et al. (U.S. 5,577,919) discusses a method for automated learning and performance evaluation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-

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4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

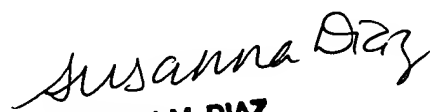
703-872-9306 [Official Communications; including After Final communications labeled "Box AF"]

703-746-7202 [For status inquiries, draft communication, labeled "Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7<sup>th</sup> floor receptionist.

  
cmc

November 20, 2004

  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**  
AU 3623